

REMARKS

The claims are not amended.

The Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Claim Rejections – 35 USC § 102(e)

Claims 10-14 are rejected under 35 U.S.C. 102(e) as allegedly anticipated by Delenstarr (U.S. 6,428,957). The Applicants respectfully traverse this rejection.

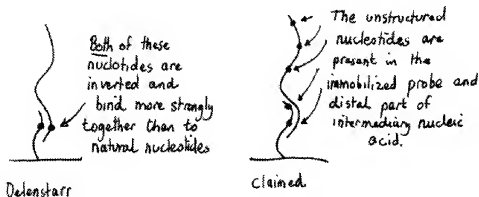
A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1566 (Fed. Cir. 1990).

The instant claims are directed to, *inter alia*, a method of assaying target nucleic acid molecules including providing a first plurality of nucleic acids in which at least one region of the nucleic acids in the first plurality is designed to be complementary to a nucleotide sequence of a second plurality of nucleic acids, in which the first plurality of nucleic acids is immobilized on a surface such that different sequences of the first plurality of nucleic acids are spatially addressed and can be differentiated by location, and in which the nucleic acid at each location has a different nucleotide sequence than nucleic acids at other locations; and providing a second plurality of nucleic acids, in which the nucleotide sequence of each nucleic acid of the second plurality is known and includes a first region and a second region, in which each first region of each nucleic acid of the second plurality has a different nucleotide sequence from other first regions of other nucleic acids of the second plurality, in which each first region of nucleic acids of the second plurality is designed to be complementary to a nucleotide sequence of the first plurality of nucleic acids.

Delenstarr is deficient in that it fails to explicitly disclose: a) an immobilized nucleic acid probe that contains an unstructured nucleotide and b) intermediary nucleic acid containing a second region containing unstructured nucleotides. As

described in the instant claims, the second region binds to target nucleic acids, and does not bind to the immobilized probe. As such, Delenstarr fails to explicitly disclose several features required by the instant claims

Without wishing to limit the claims or characterize the Delenstarr's teachings in any way, the following illustration shows these significant differences:



Further, the Applicants note that as defined on page 12 of the specification, complementary nucleic acids that contain unstructured nucleic acid bind with *reduced* stability. This is an effect that is *opposite* that of Dellenstar's inverted nucleotides, *increase* the stability of a complex. As such, Dellenstar's inverted nucleotides cannot be considered unstructured nucleotides, as required by the rejected claims.

In view of the foregoing discussion, the Applicants submit that Delenstarr falls well short of disclosing each and element of the rejected claims. This rejection should be withdrawn.

Claim Rejections – 35 USC § 102(f)

Claims 10-14 are rejected under 35 U.S.C. 102(f) as because the Applicants allegedly did not invent the claimed subject matter.

The Applicants submit that this rejection has been addressed in the response to the rejection of claims under 35 U.S.C. 102(e), above. Specifically, since the subject matter claimed in this instant case is different to the subject matter claimed by Delenstarr, there is no reason to maintain this rejection.

Withdrawal of this rejection is requested.

Rejection of claims under 35 USC § 103(a)

Claims 10-14 are rejected under 35 U.S.C. 103 over Delenstarr.

The subject matter claimed in the Delenstarr patent and the invention claimed in the instant Application were assigned to Agilent Technologies Inc. ("Agilent"), or under obligation to assign to Agilent, at the time the invention claimed in the instant application was made. As such, under 35 U.S.C. 103(c), Delenstarr cannot preclude the patentability of the instant claims, and this rejection may be withdrawn.

Withdrawal of this rejection is requested.

Double patenting

Claims 10-14 of this case are rejected on the ground of nonstatutory obviousness-type double patenting over claims 12-18, 27 and 28 of Delenstarr. The Applicants respectfully traverse this rejection.

Delenstarr's claims do not explicitly recite: a) an immobilized nucleic acid probe that contains an unstructured nucleotide and b) intermediary nucleic acid containing a second region (i.e., the region that binds to the target nucleic acids, rather than to the immobilized probe) containing unstructured nucleotide, as required by the instant claims.

Further, the Applicants note that as defined on page 12 of the specification, complementary nucleic acids that contain unstructured nucleic acid bind with *reduced* stability. This is an effect that is *opposite* that of Dellenstar's inverted nucleotides, which are present to *increase* the stability of a complex. As such, Dellenstar's inverted nucleotides cannot be considered unstructured nucleotides, as required by the rejected claims.

As such, the Applicants submit that Delenstarr's claims and the instantly claimed method are very different, and that the claimed method is not simply an obvious variant of the method claimed by Delenstarr.

The Applicants submit that this rejection has been addressed and should be withdrawn.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddie at (650) 833-7713.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10003516-1.

Respectfully submitted,

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